



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Re: Appeal to the Board of Patent Appeals and Interferences

In re PATENT application of
DESAI

Group Art Unit: 2151

Application No. 09/986,967

Examiner: TRAN, Nghi V.

Filed: November 13, 2001

Title: Arrangement for Providing Content Operation Identifiers with a Specified HTTP Object for Acceleration of Relevant Content Operations

Docket : 95-472

Date: February 13, 2008

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

- 1 ☐ **NOTICE OF APPEAL:** Applicant hereby appeals to the Board of Patent Appeals and Interferences from the decision (not Advisory Action) dated September 21, 2005 of the Examiner twice/finally rejecting claims 1-33. [] ATTACHED: Pre-Appeal Brief Request for Review
- 2 ☐ **BRIEF** on appeal in this application attached.
- 3 ☐ An **ORAL HEARING** is respectfully requested under Rule 194 (due two months after Examiner's Answer -- unextendable).
- 4 ☒ Reply Brief is attached (due two months after Examiner's Answer -- unextendable).

5. FEE CALCULATION:		Large/Small Entity	
If box 1 above is X'd, see box 12 below <u>first</u> and decide: enter		\$500/250*	\$
If box 2 above is X'd, see box 12 below <u>first</u> and decide: enter		\$500/250*	\$ 0
If box 3 above is X'd, see box 12 below <u>first</u> and decide: enter		\$1000/500*	\$
If box 4 above is X'd, enter nothing		- 0 - (no fee)	\$
6. Original due date: June 11, 2007			
7. Petition is hereby made to extend the original due date to cover the date this response is filed for which the requisite fee is attached		(1 mo) \$120 (2mos) \$450 (3mos) \$1020 (4mos) \$1590	+ \$0
8. Enter any previous extension fee paid [] previously since above <u>original</u> due date (item 6); [] with concurrently filed amendment		-	
9. Subtract line 8 from line 7 and enter: Total Extension Fee			+0
10. TOTAL FEE ATTACHED =			\$0.00

11. ☒ *Fee **NOT** required if/since paid in prior appeal in which the Board of Patent Appeals and Interferences did not render a decision on the merits.

CHARGE STATEMENT: The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any missing or insufficient fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (missing or insufficient fee only) now or hereafter relative to this application and the resulting Official document under Rule 20, or credit any overpayment, to our Account/Order No. 50-1130/95-472 for which purpose a duplicate copy of this sheet is attached. This CHARGE STATEMENT does not authorize charge of the issue fee until/unless an issue fee transmittal form is filed

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Docket No.: 95-472

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of

DESAI

Serial No.: 09/986,967

Filed: November 13, 2001

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Group Art Unit: 2151

Examiner: TRAN, Nghi V.

For: ARRANGEMENT FOR PROVIDING CONTENT OPERATION IDENTIFIERS WITH
A SPECIFIED HTTP OBJECT FOR ACCELERATION OF RELEVANT CONTENT
OPERATIONS

MAIL STOP: APPEAL BRIEF – PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

Appellant submits this Reply Brief within two months from the Examiner Answer mailed December 13, 2007, in accordance with 37 C.F.R. §41.41.

Reply Regarding the Rejection under 35 USC §102 of Claims 1, 13, 20, and 32

As demonstrated below, the Examiner's Answer fails to demonstrate that independent claims 1, 13, 20, and 32 are unpatentable under 35 USC §102 in view of U.S. Patent Publication No. 2003/0061451 by Beyda. As described below, the Examiner Answer attempts to confuse the legal anticipation analysis by raising immaterial semantic distractions regarding the Amended Appeal Brief filed September 10, 2007, while ignoring the essential claim elements.

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Page 1

The Legal Standard

As described on pages 11-12 of the Amended Appeal Brief, the Examiner has the burden of establishing that Beyda discloses each and every element of the claim such that the identical invention must be shown in as complete detail as is contained in the claim.¹ Further, anticipation cannot be established based on a piecemeal application of the reference, where the Examiner picks and chooses isolated features of the reference in an attempt to synthesize the claimed invention.² In other words, it is not sufficient that a single prior art reference discloses each element that is claimed, but the reference also must disclose that the elements are arranged as in the claims under review. *In re Bond*, 910 F.2d 831, ___, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990) (citing *Lindemann Maschinenfabrik GmbH*).

In other words, the Examiner has the burden of establishing not only that Beyda discloses an HTTP response output by a server, or that a proxy device may perform caching of requested content, but that an HTTP response is output from a server (or received by a proxy) ***in the same manner as claimed***, namely that the HTTP response output *to the device* (claims 1, 20), or received *from the destination server* (claims 13, 32), includes both the requested first content object ***and*** the content operation identifier, where the content operation identifier ***identifies*** the second content object and includes ***the directive for prefetching the second content object***.

¹As specified in MPEP §2131: “‘A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference’ *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ... ‘The identical invention must be shown in as complete detail as is contained in the ... claim.’ *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).” MPEP 2131 (Rev. 3, Aug. 2005, at p. 2100-76).

² “Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, ___, 221 USPQ 481, 485 (Fed. Cir. 1984). “Anticipation cannot be predicated on teachings in the reference which are vague or based on conjecture.” *Studiengesellschaft Kohle mbH v. Dart Industries, Inc.*, 549 F. Supp. 716, 216 USPQ 381 (D. Del. 1982), *aff’d*, 726 F.2d 724, 220 USPQ 841 (Fed. Cir. 1984).

The Examiner Answer on page 8 is legally erroneous because it disagrees with the well settled law that “the reference also must disclose that the elements are arranged as in the claims under review”, arguing that “each element of the claimed invention is not claimed in an arranged order.” The Examiner Answer fails to cite any legal authority to support the position that the applied reference need not disclose that the elements are arranged as in the claims under review. In contrast, both *In re Bond* and *Lindemann Maschinenfabrik* required a single prior art reference to disclose each and every element of the claimed invention, arranged as in the claim, *without* any requirement that there be any “arranged order” in the claims.

The Federal Circuit in *In re Bond* vacated a §102 rejection of an apparatus claim specifying a combination of control means, first circuit means, second circuit means, and delay means, because “the Board made no finding that the delay means of claim 1 and that embodied in the [applied reference] are structurally equivalent.” 910 F.2d 831, ___, 15 USPQ2d 1566, 1568. The Federal Circuit also reversed in *Lindemann Maschinenfabrik* an anticipation finding of an apparatus claim by a district court, criticizing the district court’s analysis as disregarding “the part-to-part relationships set forth in the claims *and that give the claims their meaning*.” 730 F.2d 1452 at ___, 221 USPQ at 485-486 (emphasis added).

Hence, the requirement that the §102 reference disclose the identical invention³ “arranged as in the claim” is not a requirement that the claim specify an “arranged order”: the “arranged as in the claim” requirement stresses that the §102 reference must disclose “the part-to-part relationships set forth in the claims and that give the claims their meaning.” *Lindemann Maschinenfabrik*, 730 F.2d 1452 at ___, 221 USPQ at 485-486. Hence, any attempt to apply the §102 reference without considering the claim elements “arranged as in the claim” results in an improper piecemeal application of the reference that disregards explicit claim language.

³ See, e.g., *Richardson v. Suzuki Motor Co.* in footnote 1 *supra*.

Reply Regarding Pages 7-8 of Examiner Answer

The Examiner Answer demonstrates a disregard for explicit claim features that must be considered.

For example, the Examiner Answer argues on pages 7-8 that “claims 1, 13, 20, and 32 do not recite the limitation of sending to the device an HTTP response including the first content object and directive for prefetching an identified second content object (emphasis added)”. This semantic distraction is refuted by a review of the explicit claim language.

Claim 1 specifies “identifying a content operation identifier that *identifies a corresponding second content object* determined as relevant to the first content object ... the content operation identifier including a directive for prefetching *the* second content object”, and “the HTTP response including the first content object and the content operation identifier, enabling the device to perform *the* prefetching of *the* second content object”. Hence, antecedent basis in claim 1 establishes that the content operation identifier in the HTTP response *identifies* the second content object, and the directive enables the prefetching of the second content object identified by the content operation identifier. Independent claim 20 is similar to claim 1, where antecedent basis establishes that the content operation identifier in the HTTP response *identifies* the second content object.⁴

Independent claims 13 and 32 each specify that the HTTP response “includes the first content object and a content operation identifier that specifies a directive for prefetching an *identified* second content object”.

Hence, each of the independent claims, in fact, specify that the claimed HTTP response includes the first content object and the content operation identifier that includes the directive for prefetching the second content object *identified by the content operation identifier*.

⁴Independent claim 20 specifies “a content operation identifier that identifies a corresponding second content object ... the content operation identifier including a directive for prefetching *the* second content object”, and “supplying within the HTTP response the first content object and the content operation identifier, enabling the device to perform *the* prefetching of *the* second content object”.

Moreover the Examiner Answer on pages 7-8 disregards the essential claimed features (argued on pages 10-14 of the Amended Appeal Brief) that the HTTP response includes not only the first content object that was requested in the HTTP request, but also a directive that enables prefetching of the second content object as a content operation *distinct from presentation of the first content object*. In fact, the Examiner Answer fails to address this essential claimed feature, arguing instead that the predictive prefetching of webpages and their corresponding elements by use of “element-by-element downloading” anticipates the claim language.

To the contrary, the Examiner Answer fails to appreciate the fundamental disclosure of Beyda et al., that any device receiving an HTTP request for a content object generates an HTTP response that only includes the requested content object, for presentation of the requested content object.⁵ Hence, Beyda et al. may describe that *internally* a server may initiate *its own* requests to update its own cached web pages; however, any given HTTP response will include only the requested content object for presentation of that content object.⁶

Hence, the predictive prefetching of webpages in Beyda et al. is no more than prefetching of the “first content object” that has already been requested. Moreover, the element-by-element downloading of content is not a disclosure of prefetching of second content that is “distinct from presentation of the first content object”; to the contrary, the element-by-element downloading of content is the disclosure of prefetching elements that are within the first content object. For example, the repeated reliance on paragraph 28 of Beyda for “element-by-element downloading” belies the fact that the detailed description of “this element-by-element downloading into the cache” in paragraph 28 is described in detail in paragraph 27, where “only the elements [for a requested webpage] that have undergone a change are downloaded into the cache”:

[0027] When a web page is pre-fetched, it is stored in the cache and its URL, last-access time (which, for a pre-fetched web page, will be the end of the future time period for

⁵See, e.g., Beyda et al. at para. 2-3, 12, 19-21, 27, and the Amended Appeal Brief at pages 12-13.

⁶“A prior art patent is a reference only for that which it teaches.” *Corning Glass v. Sumitomo Electric*, 9 USPQ2d 1962, 1970 (Fed. Cir. 1989).

which the pre-fetched page is anticipated to be needed), and time stamp will be recorded in the table of FIG. 2 just as though a client had requested the web page. When a client requests the pre-fetched web page, the local server 14 will perform the identical operation described above to ensure that the web page has not undergone a modification. If a modification has occurred, then only the elements which have undergone a change are downloaded into the cache per the process described above.

Hence, the element-by-element downloading is not a prefetch, but rather a downloading of elements in a web page that have already been requested by a client by its URL (see, e.g., para. 2 of Beyda), where those elements that have undergone a change relative to the prefetched web page are downloaded to update the cached web page. Hence, the element-by-element is, in fact, a *post fetch* that updates those elements within a requested web page that have undergone a change.

Further, the element-by-element downloading is executed by the server 14 and the downloaded elements are stored into a cache within the server 14. Hence, the element-by-element is not a “presentation” of the first content object, as claimed.

Even more fundamentally, Beyda consistently describes prefetching updates of elements of a web page that has already been requested by a client device. Hence, the repeated reliance on a URL or element-by-element downloading discloses no more than an HTTP response that includes only the requested web page and its elements. Hence, Beyda teaches no more than receiving an HTTP request for a web page (first content object), and outputting an HTTP response that includes only the requested web page (first content object) that *includes* the elements used for presentation of the requested web page (first content object).

Hence, Beyda does not disclose or suggest an HTTP response that includes the first content object (e.g., the requested web page and its elements used for presentation of the requested page by the device), **and** the content operation identifier including the directive for prefetching the second content object as a content operation ***distinct from presentation of the first content object***. To the contrary, Beyda describes that any device that sends an HTTP request for a specific object receives back an HTTP response that includes only the requested object.

For this reason alone the §102 rejection of independent claims 1, 13, 20, and 32 must be withdrawn.

Reply Regarding Pages 9-10 of the Examiner Answer

The Examiner Answer states on page 9 that “claims 1, 13, 20, and 32 do not recite the directive for prefetching is within an HTTP response output to/received by another device distinct from the originator of the directive (emphasis added).” The first portion of this statement (directive for prefetching is within an HTTP response) is explicitly described in each of the independent claims;⁷ hence this statement demonstrates a deliberate disregard of the claim language, especially when read in light of the disclosure that illustrates that the HTTP response includes the content operation identifier containing the directive.⁸

⁷Claim 1 specifies “receiving an HTTP request for a first content object”, and “the HTTP response including the first content object and the content operation identifier”, with “the content operation identifier including a directive for prefetching the second content object....”

Claim 13 specifies “sending an HTTP request for a first content object”, and “receiving ... an HTTP response to the HTTP request that includes the first content object and a content operation identifier that specifies a directive for prefetching an identified second content object....”

Claim 20 specifies “receiving an HTTP request for a first content object”, and “supplying within the HTTP response the first content object and the content operation identifier”, with “the content operation identifier including a directive for prefetching the second content object....”

Claim 32 specifies “sending an HTTP request for a first content object”, and “receiving ... an HTTP response to the HTTP request that includes the first content object and a content operation identifier that specifies a directive for prefetching an identified second content object....”

⁸See the “Summary of Claimed Subject Matter” at pages 2-9 of the Amended Appeal Brief.

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Further, each of the independent claims explicitly distinguish between the originator of the HTTP response (that includes the directive) that outputs the HTTP response, and the device outputting the HTTP request and receiving the HTTP response.

For example, claim 1 specifies a “method” of providing content “*to a device*”, including the method “receiving” an HTTP request for a first content object, the method “identifying a content operation identifier ... including a directive for prefetching the second content object”, and the method “sending *to the device* an HTTP response ... enabling *the device* to perform the prefetching of the second content based on *receipt* of the content operation identifier.” Hence, claim 1 specifies that the method *receives* the HTTP request, that the method sends *to the device* the HTTP response that enables *the device* to perform the prefetching of the second content object distinct from presentation of the first content object *by the device*. Hence, the method in claim 1 that receives the HTTP request and outputs the HTTP response is distinct from the device that receives the HTTP response and in response performs presentation of the first content object and prefetching of the second content object.

Claim 13 specifies a “method” of retrieving content “*for a device*”, including the method “sending an HTTP request for a first content object, received *from the device, to a destination server* specified by the HTTP request”; the method “receiving *from the destination server* an HTTP response to the HTTP request that includes the first content object and a content operation identifier that specifies a directive for prefetching ...”, the method “sending the first content object *to the device*”, and the method “prefetching the second content object in response to the content operation identifier.” Hence, the method in claim 13 that sends the HTTP request *to a destination server* and receives the HTTP response *from the destination server* is distinct from the destination server that receives the HTTP request sends back the HTTP response.

Claim 20 specifies an apparatus, namely “a server configured for providing content *to a device* according to [HTTP] protocol”. The server includes “an interface configured for *receiving* an HTTP request for a first content object and *outputting* an HTTP response.” In addition, the content operation identifier within the HTTP response is explicitly specified as “including a directive for prefetching the second content as a content operation distinct from

presentation of the first content object *by the device*”, “enabling the device to perform the prefetching of the second content object based on receipt of the content operation identifier within the HTTP response”. Hence, the claimed server of claim 20 provides content *to a device* based on supplying within the HTTP response the first content object and the content operation identifier, enabling *the device* to perform the prefetching of the second content object based on receipt of the content operation identifier within the HTTP response and distinct from *the* presentation of the first content object (by the device).

Claim 32 specifies an apparatus, namely “a proxy device” that includes “an HTTP interface configured for sending in HTTP request for a first content object, *received from the device, to a destination server* specified by the HTTP request”, and “receiving *from the destination server an HTTP response*”. The proxy device also is configured for “sending via the HTTP interface the first content object *to the device*”. Hence, the proxy device that sends the HTTP request *to a destination server* and receives the HTTP response *from the destination server* is distinct from the destination server that receives the HTTP request and sends back the HTTP response.

As apparent from the foregoing, the Examiner Answer disregards the explicit recital of “to” and “from” with respect to the HTTP request and the HTTP response containing the first content object and the content operation identifier specifying the directive. Use of the terms “to” and “from” explicitly define a *transmission* of the HTTP requests and responses between distinct entities.

Hence, the Examiner Answer disregards the essential claim limitations of: the method outputting the HTTP response *to the device* (claim 1); the method receiving the HTTP response *from the destination server* (claim 13); the server providing content *to a device* based on outputting the HTTP response that enables *the device* to perform the presentation of the first content object and the prefetching of the second content object (claim 20); the proxy device receiving the HTTP response *from the destination server* (claim 32). Consequently the Examiner Answer demonstrates an improper disregard of these explicit limitations that distinguish between the server (or method) sending the HTTP response and the device receiving

the HTTP response (claims 1 and 20), or the device (or method) receiving the HTTP response from the destination server having sent the HTTP response (claims 13 and 32) , especially when interpreted in light of the specification.⁹

Moreover, the Examiner Answer continues to improperly disregard the claim limitations that the *HTTP response itself* includes both the requested first content object and the content operation identifier that specifies the directive for prefetching. The portions of Beyda relied upon in the Examiner Answer describe internal operations by the local server, not the HTTP response sent from the remote server 18 to the local server 14. As described above, the element-by-element downloading is performed internally by the local server 14 determining whether a cached web page has elements that need to be updated: the elements, however, are part of the presentation of the requested web page that has been cached within the local server 14, and therefore are not distinct from the presentation of the first content object, as claimed.

In contrast, the claims specify the HTTP response includes the first content object requested by the device, *and* the directive for prefetching the second content object. Hence, the device receiving the HTTP response can execute presentation of the requested first content object, *and* execute prefetching of the second content object *distinct* from the presentation of the first content object. As described on pages 15-16 of the Appeal Brief, the broadest reasonable interpretation for “prefetching” cannot be inconsistent with the specification, which explicitly describes prefetching as fetching new content without relying on a client request to provide content acceleration (see, e.g., Title, page 10, line 12 to page 11, line 2) of the second content object. Hence, Beyda fails to disclose or suggest that the HTTP response, that includes both the first content object and the directive for prefetching, is sent *to the device* in claim 1, received *from the destination server* in claims 13 and 32, and output *by the interface of the server* of claim 20.

⁹See, e.g., the Summary of Claimed Subject Matter at pages 2-9 of the Amended Appeal Brief.

For these and other reasons, the § 102 rejection of independent claims 1, 13, 20, and 32 should be withdrawn.

Reply Regarding the Rejection under §103

The Examiner Answer fails to demonstrate that the § 103 rejection of claims 3-4, 6, 8-9, 11, 15-16, 18, 22-23, 25, 27-28, 30, 34-35, and 37 should not be reversed.

Claims 3, 6, 8, 11, 15, 22, 25, 27, 30, 34, and 37 each specify that the content operation identifier in the HTTP response contains a ***directive tag*** (or an extensible HTTP header) specifying the corresponding operation and an object identifier specifying a location of the second content object. In addition, claims 3, 8, 22 and 27 specify the specific operation of ***adding*** to the first content object a content operation tag that specifies the content operation identifier including the directive tag.

The Examiner Answer provides a tortured interpretation of Schloss by disregarding the teachings of Schloss that the noncacheable content is replaced with an identifier, and does not disclose or suggest adding a ***directive*** (or an extensible HTTP header), as claimed. While the Examiner Answer attempts to again argue immaterial semantic distractions by stressing that “replace” is “to put something new *in the place of*”, the Examiner Answer focuses on the “to put something new” to assert Schloss teaches “adding”, while ignoring the “*in the place of*” which requires removal of the item being replaced.

Further, the reliance on the segment tag 330₁' on page 11 of the Examiner Answer (with respect to Figs. 3-4) disregards the explicit teaching at Schloss at col. 5, lines 36-65 that the persistent fragments 330₁ and 330₃ of Fig. 3 are replaced in Fig. 4 with the identifiers “include HREF = ‘125.1’” and “include HREF = ‘28.3’”. Hence, the Examiner Answer continues to disregard the consistent teachings of Schloss of replacing portions of a web page (persistent object fragments) with identifiers in the web page in order to improve the caching ability of the

web page.¹⁰

The Examiner Answer also fails to address the hypothetical combination presented on pages 18-19 of the Amended Appeal Brief, where the hypothetical combination still would neither disclose nor suggest the claimed **adding** in claims 3, 8, 22, and 27 to the first content object a **directive tag**, let alone receiving an HTTP response that includes the first content object **and the directive tag**, as specified in claims 3, 8, 15, 22, 27, and 34, or an HTTP response that includes an extensible HTTP header as specified in claims 7, 11, 25, and 30. Rather, the hypothetical combination simply would teach replacing uncacheable objects with identifiers. Consequently, the hypothetical combination would remove the first content object and replace the first content object with a persistent object fragment identifier. Hence, the hypothetical combination would provide an HTTP response that does not include the first content object, but instead includes the persistent object fragment identifier in place of the first content object. Regardless, the hypothetical combination still would not disclose or suggest the claimed HTTP response including the first content object **and** the content operation identifier in the form of a content operation tag, as claimed.

Hence, the §103 rejection fails to demonstrate that it would have been obvious to arrive at the claimed combinations. “[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” *KSR Int’l v. Teleflex, Inc.*, Slip op. at 13, 82 USPQ 2d 1385, 1396 (U.S. Apr. 30, 2007).

For these reasons alone, the §103 rejection should be reversed.

Conclusion

For the reasons set forth above, it is clear that Appellant’s claims 1-4, 6, 8-9, 11, 13-16, 18, 20-23, 25, 27, 28, 30, 32-35 and 37 are patentable over the references applied. Accordingly

¹⁰“A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. MPEP §2141.02, page 2100-126 (Rev. 6, Sept. 2007) (citing *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984))(emphasis in original).

the appealed claims 1-4, 6, 8-9, 11, 13-16, 18, 20-23, 25, 27, 28, 30, 32-35 and 37 should be deemed patentable over the applied references. It is respectfully requested that this appeal be granted and that the Examiner's rejections be reversed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'L. R. Turkevich', with a stylized flourish at the end.

Leon R. Turkevich
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February 13, 2008